

**REMARKS**

Claim 1 is amended herein by replacing the phrase “which comprises” with the phrase “consisting essentially of”. Claim 15 which originally depended from claim 8 is amended herein by incorporating the subject matter from claim 8 since claim 8 is withdrawn from consideration as a non-elected invention.

No new matter is presented.

**I. Response to Obviousness-Type Double Patenting Rejections**

**A. U.S. App. Ser. No. 10/123,113 (US 2002/0192463)**

Claims 14 and 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 13 and 14 of copending Application No. 10/123,113 (US 2002/0192463).

**B. U.S. App. Ser. No. 10/404,861 (US 2003/0203193)**

Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/404,861 (US 2003/0203193).

**C. U.S. App. Ser. No. 10/415,948 (US 2004/0038020)**

Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/415,948 (US 2004/0038020).

Applicants respectfully defer responding to the provisional obviousness-type double patenting rejections.

## **II. Response to Claim Rejections Under 35 U.S.C. § 102**

Claims 1-7, 14 and 15 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Oshima et al (EP 1 033 393 A2).

Applicants traverse the rejection.

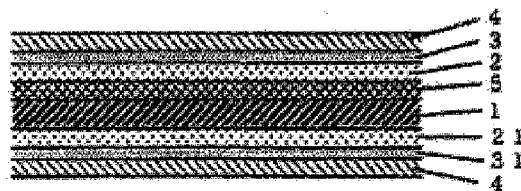
Without conceding the merits of the rejection, claim 1 is amended herein to recite a heat-peelable double-faced pressure-sensitive adhesive sheet *consisting essentially of* a substrate (a), a heat-peelable pressure-sensitive adhesive layer (b) formed on one side of the substrate (a) and containing heat-expandable microspheres, and a pressure-sensitive adhesive layer (c) formed on the other side of the substrate (a), wherein the heat peelable pressure-sensitive adhesive layer (b) and the substrate (a) are peelable from each other by heating.

The present invention is characterized in that peeling occurs between the substrate and the heat-peelable pressure-sensitive adhesive layer (heat-expandable layer). In this connection it is submitted that the adhesive layer (b) of the adhesive sheet of the present invention may be formed by, for example, a method in which a mixture comprising heat-expandable microspheres and a pressure-sensitive adhesive is applied to the substrate (a). Alternatively, a method may be employed in which the mixture is applied to an appropriate separator to form the adhesive layer (b), which is then transferred to the substrate (a). Preferably, the side of the substrate (a) on which the adhesive layer is applied may have undergone a releasability-imparting treatment prior to the application of the adhesive layer (specification page 6, lines 22 to 24). This results in the

formation of an adhesive sheet in accordance with claim 1 of the present invention, consisting essentially of an adhesive layer (b) and a substrate (a) which are peelable from each other by heating. Consequently, the adhesive layer and the substrate of the adhesive sheet are separated from each other by heating.

On the other hand, Ohshima et al does not disclose, teach or suggest this feature of the presently claimed invention.

The Examiner relies on Figure 2 of Ohshima, which is reproduced below. In Figure 2 Ohshima et al discloses a heat-peelable pressure sensitive adhesive sheet comprising a substrate 1, a heat-expandable layer 2 formed on one side of the substrate comprising heat-expandable microspheres with a binder which is preferably a pressure-sensitive adhesive and a pressure-sensitive adhesive layer 3 formed on the other side of the substrate. A rubber-like organic elastic layer 5 is provided as an intermediate layer between the heat-expandable layer 2 and the substrate 1. A further pressure sensitive adhesive layer 31 is superposed on heat-expandable layer 21.



However, Ohshima et al does not disclose that the pressure-sensitive adhesive layer containing heat-expandable microspheres and the substrate are peelable from each other by heating. In Ohshima et al, since a rubber-like organic elastic layer is present between the substrate and the heat-expandable layer, the expansion of the heat-expandable microspheres

Amendment under 37 C.F.R. § 1.116  
U.S. App. Ser. No. 10/810,700

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contained in the heat-expandable layer is absorbed and therefore, peeling does not occur between the substrate and heat-expandable layer. Again, the adhesive sheet of Oshima et al is peeled from an adherend as a whole. Thus, Oshima et al does not disclose, all elements of the present claims and cannot be said to anticipate the present invention.

Additionally, the present is not rendered obvious by Oshima et al for the reasons set forth in the Response filed September 29, 2006.

Accordingly, Applicants respectfully request withdrawal of the §102 rejection.

### **III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

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Jennifer M. Hayes  
Registration No. 40,641